

REMARKS

Claims 2, 3, 5, 6, 8-10, 12, and 46-49 are currently pending within this application. No Claims have been added, amended, or canceled.

The Office has rejected Claims 2-3, 5-6, 8-10, 12 and 46-49 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant reminds the Office that the claims are to be read in light of the specification; proper basis has been provided for the term “generally” as it pertains to the T-shaped composite therein. The drawings clearly provide a depiction of such a composite and a proper description as to the necessity of such a shape. The further limitations in the independent claim as to embrasure tabs and an incisal tab further clarify the term as well. As the limitation is intended merely to ensure that a proper configuration for a tooth to be enveloped in total by the composite when the embrasure tabs and incisal tab are properly folded around a subject tooth, even with the broader modifier of “generally” present, the ordinarily skilled artisan would have no problem clearly understanding the breadth of the claimed invention as now written in the pending claims. Reconsideration and withdrawal of such a rejection are therefore earnestly solicited.

The Office has rejected Claims 2-3, 5-6, 8-10, 12 and 46-49 under 35 U.S.C. §103(a) as being unpatentable over Wiesel in view of Subelka et al. and further in view of Cohen. Upon review of these prior art references, it is respectfully submitted that this combination of prior art is improper and any combination considered proper thereof still does not provide a sufficient teaching as to render the pending claims unpatentable. Wiesel, as noted by the Office, fails to teach a dental restorative composite of any type. The Office has determined, however, that the

possible teachings by patentee is sufficient as a suggestion to incorporate any dental restorative composite, such as in Subelka et al. However, upon review of the pertinent language cited by the Office within Wiesel, Applicant vehemently disagrees with the Office's position. The cited paragraph reads:

"Although the invention has been described in connection with a system for whitening teeth, it must be understood that this is merely the preferred embodiment. It should be readily apparent to those skilled in the art that the invention could be used for otherwise treating the teeth. For example, a desensitizing agent or substantially any other substance or medicament could be applied using the invention. This can be accomplished simply by substituting the desensitizing agent or other material for the whitening agent in the gel." Wiesel, col. 6, lines 5-14

A dental restorative composite is simply not the same type of tooth treatment clearly of concern to Wiesel in this paragraph. A restorative is utilized not as a treatment for contacting a tooth for aesthetic whitening or therapeutic reasons *per se*, but rather, just as the name implies, for tooth restoration. When a restorative composite is utilized, the subject tooth may be only partially in existence; Wiesel seeks merely to treat, rather than rebuild synthetically, a tooth completely in place. Furthermore, Wiesel specifies in the aforementioned paragraph that any such treatment is merely a substitute agent for his whitening material, such as a desensitizing agent or a medicament, within the gel portion of his entire product. One of ordinary skill would recognize that a restorative, such as, for example bis-GMA, cannot simply be added to a gel formulation in place of any other component. Quite to the contrary, such restorative composites are extremely adhesive and susceptible to quick oxidation and curing through environmental exposure. On its face, in Applicant's opinion, the combination of Wiesel with any dental restorative composite or procedure is untenable as there would be no reason for one of ordinarily

skill within the dental restorative composite art (or dental whitening or therapeutic treatment art, for that matter) to view these two references in tandem at all.

Furthermore, Wiesel fails to specify any materials for his carrier film portion other than medical grade silicone, medical grade acrylic acids, or cellulose products. No polyester film is mentioned anywhere within this reference at all. A review of Subelka et al. shows that their restorative procedure fails to utilize any film carriers at all. Patentees merely disclose a new restorative composite to be applied directly to a tooth. Of great interest is the fact that Applicant's claimed invention is intended as an improvement over the exact method as taught by Subelka et al. in that patentees' procedures would experience the same problems in composite manipulation that Applicant's inventive kit was developed to overcome. The extreme adhesive quality of such a composite, coupled with the rapid curing upon exposure to suitable environments make it very difficult for the dental professional to properly apply such a composite to a tooth and sculpt a proper resultant shape quickly and without having the spatula (or other sculpting tool) adhere itself to the target composite, not to mention without having the composite attach to an adjacent tooth surface. Subelka et al. fail to even mention that any problems exist to such a degree as was recognized by Applicant. Even with that being as it is, there is no film carrier even suggested within Subelka et al.'s teachings that would remedy this shortcoming prevalent within the primary Wiesel reference.

In addition, there is nothing within either reference of a generally T-shaped composite, film, or design of any type. Applicant requires such a shape for the purpose of enveloping the target tooth to prevent the adhesive composite from contacting an adjacent tooth as well as the

sculpting tool to be utilized by the dental professional thereafter. This important limitation has been properly and thoroughly described within the independent claim for such a purpose. Neither Wiesel nor Subelka et al. provide any teaching that remotely concerns such an important aspect of the claimed invention. Nor do these references provide any reason why any such shape would be of importance or would be an alternative to the rectangular shape specified within Wiesel. As Wiesel is, again, concerned solely with whitening teeth for aesthetic reasons (or, as noted above, possibly concerned with medical treatments), there is no suggestion that a different configuration would provide any improvement or benefit otherwise. The Office cites Cohen as showing a T-shaped tooth covering for etchant delivery. There is nothing within this reference of the necessity of or even the possibility of providing such a configuration for the purpose of applying a restorative composite to a tooth. Such a configuration is but one manner of delivering a tooth etchant to a tooth surface. Complete coverage of a tooth is not a requirement within Cohen; to the contrary, the drawings clearly show that coverage over only a small portion of a tooth is of interest.

In addition, as noted above, neither the primary nor secondary reference teaches a polyester film as now required within the instant claims; Cohen fails to teach such a limitation either. Cohen specifies that his tooth etchant impregnated matrix is of resilient porous material (foamed inert plastics) or like material lending itself to fabrication into a resilient liquid absorbing pad (col. 2, lines 57-62). Polyester meets neither of these requirements, clearly. The polyester of the instant invention is necessary to allow for removal from the cured composite after sculpting; an absorbent, porous material would militate against such a possibility.

Furthermore, as noted above, Cohen utilizes this matrix material to carry an etchant to a specific area of a tooth and deliver over time.

The Office has improperly combined these three references for the reasons noted above. Furthermore, even if such references were properly combined, the entire disclosure of all three references fails to teach the same limitations of the presently claimed invention. Reconsideration and withdrawal of this improper obviousness rejection are therefore earnestly solicited.

CONCLUSION

In view of the remarks supplied above, it is respectfully submitted that the present claims of this application are now in condition for allowance and that this case be passed on to issue.

Respectfully submitted,

/H Roy Berkenstock/

April 9, 2008

H. Roy Berkenstock
Attorney for Applicant
Registration Number 24,719
Telephone: (901) 537-1108

WYATT, TARRANT & COMBS, LLP
1715 Aaron Brenner Drive
Suite 800
Memphis, Tennessee 38120-4367